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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* REINER KRAFT

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Appeal 2008-0875  
Application 09/825,210  
Technology Center 2100

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Decided: August 14, 2008

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Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 5, 6, 8-11, 15, 16, 18-22, and 24-26.<sup>1</sup>

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<sup>1</sup> We note that claims 15, 16, 18, and 19 improperly depend directly or indirectly from a cancelled claim (claim 13 was cancelled by the Amendment received on Sept. 27, 2004).

Claims 2-4, 7, 12-14, 17, and 23 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

## THE INVENTION

The disclosed invention relates generally to the field of data processing, and particularly to a software system and associated method for use with computers and documents on the Internet. More specifically, Appellant's invention is directed to a system for saving the content of a target document bundled with contextual metadata, such as the location of a source document, as attributes of the target document (Spec. 1).

Independent claim 1 is illustrative:

1. A method of associating a destination document to a source document during a save operation, comprising:
  - defining contextual metadata of the source document, wherein the contextual metadata includes a location of the source document;
  - identifying a target document by a content and contextual data;
  - bundling the target document, and the contextual metadata of the source document as attributes of the target document;
  - saving a bundled target document as the destination document;

wherein bundling the target document comprises merging the contextual metadata of the source document and the contextual data of the target document as attributes of the target document;

automatically synchronizing the destination document to the target document, to reflect changes in the target document; and

wherein defining the contextual metadata of the source document further includes defining a navigation path from the source document to the target document, to enable a client to return to the source document from the target document, even if one or more intermediate documents along the navigation path no longer exist.

#### THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Lumsden	US 6,006,217	Dec. 21, 1999
Heninger	US 6,470,349 B1	Oct. 22, 2002 (filed Mar. 11, 1999)
Logan	US 6,665,659 B1	Dec. 16, 2003 (filed Feb. 1, 2000)

#### THE REJECTIONS

1. Claims 1, 5, 6, 10, 11, 15, 16, 20-22, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan in view of Heninger.

2. Claims 8, 9, 18, 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Logan in view of Heninger and Lumsden.

#### PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Brief to show error in the proffered *prima facie* case.

#### ANALYSIS

Claims 1, 5, 6, 10, 11, 15, 16, 20-22, and 26.

We consider the Examiner’s rejection of claims 1, 5, 6, 10, 11, 15, 16, 20-22, and 26 as being unpatentable over Logan in view of Heninger. Since Appellant’s arguments with respect to this rejection have treated these

claims as a single group which stand or fall together, we select independent claim 1 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We consider the following issues that flow from the contentions of the Appellant and the Examiner:

We consider first the question of whether Logan's citations teach and/or suggest a "destination document," as claimed (claim 1).

Appellant notes that the Examiner has read the claimed "destination document" on one of Logan's citations (Br. 13). Appellant restates the Examiner's finding that Logan teaches that each citation is preferably expressed as a valid XML document (Br. 13; *see also* Ans. 9; Logan, col. 5, ll. 13-14). Nevertheless, Appellant argues a definition from the Specification as to the meaning of a "destination document," as that term is used regarding the present invention (Br. 14). In light of this definition, Appellant contends that the claimed "destination document" is not taught by Logan (*id.*).

It is the Appellant's burden to precisely define the invention, not the PTO's. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to

be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Here, when we consider Appellant's definition in the Specification, we note that Appellant prefaces the definition for a "destination document" with an express statement that "[t]he following definitions . . . are intended to facilitate the understanding of the present invention without limiting its scope," as follows:

The following definitions and explanations provide background information pertaining to the technical field of the present invention, and are intended to facilitate the understanding of the present invention *without limiting its scope*:

. . .

Destination document: A final document or web page which is comprised of a target document that is bundled with contextual data about the source document.

(Spec. 6, ll. 2-4 and 10-11, emphasis added).

Because Appellant's definition for a "destination document" is clearly *not intended to limit the scope* of the claimed subject matter, it is our view that the record before us supports the Examiner's finding that the claimed "destination document" is taught and/or suggested by Logan's citations (Ans. 9; *see also* Logan, col. 2, ll. 1-9). As pointed out by the Examiner,

Logan expressly teaches that each citation is preferably expressed as a valid XML document (Ans. 9; *see also* Logan, col. 5, ll. 13-14).

We consider next the question of whether the combination of Logan and Heninger teaches and/or suggests synchronization between target and destination documents, as argued by Appellant (Br. 15).

While Appellant argues that “Logan does not describe target documents that are synchronized with the destination documents” (Br. 15, ¶2), we note that the Examiner has relied on Heninger for the teaching and/or suggestion of the claimed synchronization (Ans. 5). Nevertheless, Appellant further contends that “even if Heninger describes synchronization between documents, it still does not describe the synchronization between the target and destination documents . . . .” (Br. 15, ¶2).

In response, we note that the Examiner has relied upon Logan for the teaching and/or suggestion of the claimed “destination documents.” (Ans. 4). The Examiner looks to the secondary Heninger reference for the express teaching of “ensur[ing] that the target stays synchronized with the source.” (Heninger, col. 16, ll. 19-20) (Ans. 5). The Examiner’s rejection is based upon the *combination* of Logan and Heninger.

However, Appellant’s arguments are directed to the individual references in isolation rather than the combination of references as a whole. The Court of Appeals for the Federal Circuit has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800



F.2d 1091, 1097 (Fed. Cir. 1986). Therefore, we see no error in the Examiner's reasoning, as articulated on pages 10 and 11 of the Answer.

Appellant further argues:

More specifically, the present invention recites automatically synchronizing the destination document to the target document, to reflect changes in the target document. **The synchronization step, in conjunction with the bundling step, enable the present invention to track down the source document even if the intermediate documents change.** This feature is not taught in the cited references, whether considered individually or in combination with each other, and none of the references suggests such combination. As a result, the two cited references cannot be properly combined.

(Br. 15).

The Examiner disagrees. The Examiner contends that Appellant is arguing limitations that are not recited in the claim (Ans. 11).

After considering the record before us, we agree with the Examiner's position. We note that patentability is based upon the claims. "It is the *claims* that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Here, we note that the language of the claim actually recites in pertinent part: "to enable a client to return to the source document from the

target document, even if one or more intermediate documents along the navigation path *no longer exist*.” (Claim 1, emphasis added). We agree with the Examiner that the argued limitation of “even if the intermediate documents *change*” (as argued by Appellant) is not the same as the recited limitation of “even if one or more intermediate documents along the navigation path *no longer exist*” (as claimed) (emphasis added). The only mention of “changes” recited in claim 1 is with respect to the target document: i.e., “automatically synchronizing the destination document to the target document, to reflect *changes* in the target document” (claim 1, emphasis added). We have considered Appellant’s arguments only to the extent that they are directed to claimed subject matter. Moreover, because the claimed “intermediate documents along the navigation path [may] *no longer exist*,” it is unclear whether the “intermediate documents” are part of the claimed invention or not (claim 1, emphasis added).

On this record, we conclude that Appellant has not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s rejection of representative claim 1 (and claims 5, 6, 10, 11, 15, 16, 20-22, and 26 that fall therewith) as being unpatentable over Logan in view of Heninger. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Dependent claims 8, 9, 18, 19, 24, and 25

We note that dependent claims 8, 9, 18, 19, 24, and 25 were not separately argued in the Brief. Therefore, we sustain the Examiner’s

rejection of claims 8, 9, 18, 19, 24, and 25 as being unpatentable over Logan in view of Heninger and Lumsden for the same reasons discussed *supra* with respect to representative independent claim 1. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).

#### CONCLUSION OF LAW

We conclude that Appellant has not met his burden of showing that the Examiner erred in rejecting claims 1, 5, 6, 8-11, 15, 16, 18-22, and 24-26 under 35 U.S.C. § 103(a) for obviousness.

#### DECISION

We affirm the Examiner's decision rejecting claims 1, 5, 6, 8-11, 15, 16, 18-22, and 24-26 under 35 U.S.C. § 103(a) for obviousness.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

#### AFFIRMED

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